

Response

Applicants, through their attorney, respectfully request the Examiner to consider the application in view of the included amendments and remarks.

Support

Applicants have amended claims 1, 2, 15 and 21 by adding the modifying term “organic solvent based” to every instance of “functional fluid”. Support for these amendments is found in claim 1 as well as on page 4, lines 3-4 of the specification.

No other elements of the claims have been amended.

Remarks

The Examiner rejected claims 1-15 and 21 under 35 U.S.C. §112 as being indefinite, stating that it was unclear if the previous amendment describing the functional fluid as an organic solvent based functional fluid applied to the instances of functional fluid in the body of the claims. Applicants respectfully disagree.

Applicants have amended claims 1, 2, 15 and 21, modifying all instance to “functional fluid” to read as “organic solvent based functional fluid” as the Examiner suggested in the office action. Applicants respectfully submit that the present claims are not indefinite and ask that the rejections be removed. Applicants believe this renders claim 21 allowable.

The Examiner has also rejected claims 1-15 under §102(b) as being anticipated by Becket (US 5,710,372). The Examiner states that Applicants argument that Becket is limited to aqueous fluids is not persuasive due to the disclosures in Becket at column 14, lines 11-14. Applicants respectfully disagree.

Applicants point out that Becket clearly states that the methods it teaches are “specific to aqueous fluid compositions” at column 11, lines 30-32. Becket does note it is not limiting the constituents that may be present in those aqueous fluid compositions, such as the lubricant components described in column 14. Becket is very consistent in making it clear its teachings are focused on and limited to aqueous fluid compositions. Please refer to the following sections of Becket for some of the many, and very consistent, instance where the reference makes it clear it is limited to aqueous compositions: the abstract; column 1, lines 5-10; column 1 lines 37-40; column 4, lines 14-13, 29-31, 45-47 and 65-67; column 5, lines 12-18; and column 11, lines 30-36 and 49-53 of the reference.

Applicants point out the list of materials the Examiner refers to at column 14, lines 13-14 are provided as examples of lubricants that may be useful in the aqueous based

machining fluids the reference deals with. The reference teaches that its aqueous fluids may contain components such as lubricants and additives and then provides a few examples of each. Nowhere is it taught that the fluids of the Becket are organic, in fact the consistent language used throughout Becket makes it clear that the fluids involved are in fact aqueous in nature and that the invention of Becket is limited to such aqueous fluids.

In contrast the present invention requires an organic solvent based functional fluid. This feature is not taught in Becket. As Becket fails to teach a required feature of the invention, Applicants respectfully request all §102 rejections based on Becket be removed.

Furthermore, Applicants note that Becket provides no motivation to use its teachings in organic fluids. One skilled in the art reviewing Becket would conclude that the teachings of Becket are limited to aqueous fluids, because 1) Becket states this explicitly (at column 11, lines 30-35, as discussed above), and 2) the language throughout Becket is consistently limited to aqueous fluids. Therefore Applicants respectfully submit that the present invention is non-obvious over the reference and no §103 objection should be made. Applicants believe this renders all claims allowable over Becket.

Conclusion

For the foregoing reasons it is submitted that the present claims are novel and unobvious over the cited reference, and in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. Therefore an early and favorable reconsideration is respectfully requested. If the Examiner believes that only minor issues remain to be resolved, a telephone call to the Undersigned is suggested.

Any required fees or any deficiency or overpayment in fees should be charged or credited to deposit account 12-2275 (The Lubrizol Corporation).

Respectfully submitted,
THE LUBRIZOL CORPORATION

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